

USSN: 10/699,586
Group Art Unit: 3739
Docket No.: 151P11200US01

REMARKS

Claims 9, 13 – 15 and 22 – 24 are pending in this application.

Claims 1 – 8, 10 – 12 and 16 – 21 have been canceled.

Claims 1 and 6 – 9 and 13 – 24 have been rejected.

Amendments to the Claims

Claims 1, 6 – 8 and 16 – 21 have been canceled, without prejudice.

Claim 1 has been amended to clarify that the method includes creating a burr hole, to clarify that electrical current is applied to the tip of the stylet and to correct antecedent basis for "stylet." No new matter has been added.

Examiner Interview

Applicant appreciates the telephonic interview on June 21, 2007. Method claims 9, 13 – 15 and 22 – 24 were discussed. It was acknowledged that claims 9, 13 – 15 and 22 – 24 contain allowable subject matter. Formalities of claim 9 were discussed and the result of that discussion is contained in the amendment of claim 9 in this paper. Claims 13 – 15 and 22 – 24 were reviewed and found to have no structural problems.

Rejections Under 35 USC § 112

Claims 9, 13 – 15 and 22 – 24 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections over claims 9, 13 – 15 and 22 – 24 are respectfully traversed.

The Examiner states "the claims recite a hemispherical shape with a diameter approximately equal to the first predetermined diameter. The first predetermined diameter is defined as the diameter of the hole in the dura that is being made by the invention. Therefore,

USSN: 10/699,586
Group Art Unit: 3739
Docket No.: 151P11200US01

the meets and bounds of the claims are unclear since the size of the apparatus is not known until the size of the dura has been established.” Applicant respectfully notes that claim 9 is a method for making a hole of a particular size, not an apparatus claim for a stylet. Claim 9, line 1 requires “a method of making a hole of a first predetermined diameter”. To do that, a user first “determine[es] whether to create a burr hole” (line 4) and then “insert[s] a first end of said stylet ... with a diameter approximately equal to said first predetermined diameter” (line 5 – 6). It is respectfully submitted that the meets and bounds of the method are entirely clear: a medical professional determines a hole of a particular size is needed in the dura, so the medical professional selects a stylet approximately equal to that particular size. The method of claim 9 is not keyed off of the stylet, it is keyed off of the size of the hole that a medical professional needs to create in the dura.

Claim 9 requires a method for creating a hole in the dura of a particular size, not an apparatus for creating a hole in the dura. Thus, claim 9 cannot be indefinite for failing to particularly point out and distinctly claim the size of the apparatus, as a method claim is not required to particularly point out and distinctly claim the size of an apparatus. Thus, it is respectfully submitted that the rejection of claim 9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is improper and should be withdrawn.

Claims 13 – 15 and 22 – 24 are dependent on claim 9, and thus incorporate all of the limitations of claim 9. Because the rejection of claim 9 under 35 U.S.C. § 112, second paragraph is inappropriate, it is respectfully submitted that the rejection of claims 13 – 15 and 22 – 24 is likewise inappropriate for the same reason and should be withdrawn.

Rejections Under 35 USC § 102(e)

Claims 1, 6 – 8 and 17 – 21 have been canceled, and thus their rejection under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,761,718 (“Madsen et al ‘718”) has been rendered moot.

USSN: 10/699,586
Group Art Unit: 3739
Docket No.: 151P11200US01

Summary

In view of the arguments presented, claims 9, 13 – 15 and 22 – 24 should be allowable, this application should be in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

Date: June 21, 2007

By: William D. Bauer
William D. Bauer
Reg. No.: 28,052
IPLM Group, P.A.
Post Office Box 18455
Minneapolis, MN 55418
Telephone (612) 331-7405

WDB:adk